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10/634,885	08/06/2003	Tetsuya Ouchi	116787	7541

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EXAMINER
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BRINEY III, WALTER F

ART UNIT	PAPER NUMBER
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2646

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/634,885

Applicant(s)

OUCHI ET AL.

Examiner

Walter F. Briney III

Art Unit

2646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-26 and 28-32 is/are rejected.
- 7) ☒ Claim(s) 8 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1, 2, 4-6, 11, 12, 15-17, 19, 20, 21, 23-25, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pietrowicz et al. (US Patent Application Publication 2003/0026244) in view of Wu et al. (US Patent 6,480,581).**

**Claim 1** is limited to *an IP telephone apparatus for executing a telephone call through a computer network*. Pietrowicz discloses a desktop appliance that integrates analog PSTN and digital packet voice communications. See Abstract. Figure 1 depicts the most general embodiment of the device, wherein all features are integrated within one package. As is clear from the figure, Pietrowicz discloses a desktop appliance (100), i.e. *a main unit*, which includes a built-in *handset* (152); but also includes an audio port (156) for other external telephony devices (160), i.e. *an external telephone connection unit being connectable to an external telephone having a handset*. The analog interface (132) provides connection to the PSTN, i.e. *a telephone line connection unit that connects to a telephone network*. The digital interface provides connection to the packet network, i.e. *an audio signal input/output unit that inputs/outputs an audio signal for conversation*. Even though figure 1 of Pietrowicz includes several other functional blocks that hint at certain features of the claimed invention, there is no explicit

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or implicit suggestion of a *dialing start command detection unit configured to detect an IP telephone dialing start command*. The disclosure of Pietrowicz is incomplete in describing how one of ordinary skill would select an outgoing network. Accordingly, reference is made to Wu to resolve these deficiencies.

Wu teaches an internet/telephone adapter device. See Abstract. As illustrated in figure 1, the adapter allows a normal telephone to be connected to either an analog or digital network. Furthermore, Wu teaches the detailed operation behind making and receiving telephone calls. In particular, and with reference to figure 4A, Wu teaches first detecting an off-hook signal from the connected handset, thus enabling a DSP to detect DTMF signals (402). Upon detection of a predetermined DTMF input (403) the procedure is routed toward calling number decoding (408). By detecting the DTMF input at step (403), the procedure is effectively determining whether the user wishes to operate in a PSTN or Packet mode. This implies the existence of a *dialing start command unit*, while step (402) implies the existence to a *handset validation unit*. Returning to figure 1 of Pietrowicz, it is clear that the switching and bridging system (136) corresponds to an *audio signal path switching unit*, the VoP telephony processor (138) corresponds to a *network communication control unit*, and the digital interface (140) corresponds to a *network terminal*. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the operating procedure as taught in figure 4A and 4B of Wu for the purpose of allowing a user of the dual-network appliance disclosed by Pietrowicz to select the desired network to which an outgoing call will be made.

**Claim 2** is limited to *the IP telephone apparatus as claimed in claim 1*, as covered by Pietrowicz in view of Wu. As noted in the rejection of claim 1, the disclosure of Pietrowicz is incomplete in describing the process steps required for an integrated dual-network appliance to connect to a packet-based network. Therefore, reference is again made to Wu. Continuing from step (408) of figure 4A, the process routes to point A of figure 4B. From there, the process logs into the internet and performs TCP connection in order to complete connection over the packet network. These steps imply the existence of *a control signal input/output unit*. The *computer* is an inherently present device at the receiving end of the adapter. Therefore, Pietrowicz in view of Wu makes obvious all limitations of the claim.

**Claim 4** is limited to *the IP telephone apparatus as claimed in claim 1*, as covered by Pietrowicz in view of Wu. The audio port (156) disclosed by Pietrowicz corresponds to *an external machine connection terminal*, as it provides connection to the external audio device (160). Therefore, Pietrowicz in view of Wu makes obvious all limitations of the claim.

**Claim 5** is limited to *the IP telephone apparatus as claimed in claim 1*, as covered by Pietrowicz in view of Wu. The procedure taught by Wu detects an IP telephone dialing start command at step (403) of figure 4A, clearly the predetermined DTMF key is either pressed or not (i.e. *wherein the dialing start command detection unit detects the IP telephone dialing start command based on the presence or absence of an IP dialing command*). Therefore, Pietrowicz in view of Wu makes obvious all limitations of the claim.

**Claim 6** is limited to *the IP telephone apparatus as claimed in claim 1*, as covered by Pietrowicz in view of Wu. As depicted by the procedure of figure 4A, the dual-network device first detects an off-hook signal so the DSP can be placed in condition to detect DTMF signals (402) (i.e. *wherein the handset validation unit detects an off-hook signal generated from one of the handset of the main unit and the handset of the external telephone and validates the handset corresponding to the detected off-hook signal*). Therefore, Pietrowicz in view of Wu makes obvious all limitations of the claim.

**Claim 11** is limited to *the IP telephone apparatus as claimed in claim 5*, as covered by Pietrowicz in view of Wu. Packet-based telephony mode is selected by entering a predetermined DTMF signal (403) (i.e. *wherein the IP telephone command is generated by operating a general telephone function within one of the IP telephone apparatus and the external telephone, the general telephone function for telecommunicating by use of the telephone network*). Therefore, Pietrowicz in view of Wu makes obvious all limitations of the claim.

**Claim 12** is limited to *the IP telephone apparatus as claimed in claim 11*, as covered by Pietrowicz in view of Wu. DTMF signals are entered by way of a telephone receiver's touchpad (i.e. *wherein the IP telephone command is input with a predetermined button of one of the IP telephone apparatus and the external telephone*). Therefore, Pietrowicz in view of Wu makes obvious all limitations of the claim.

**Claim 15** is limited to *an IP telephone system* whose components are analogous in nature to those recited in claim 2, and is rejected for the same reasons.

**Claim 16** is limited to *the IP telephone system as claimed in claim 15*, as covered by Pietrowicz in view of Wu. In claim 2, the dual-network adapter was shown to perform an internet login procedure at step (418) and a TCP connection at step (420). These procedures inherently require bidirectional communication, thus *the computer outputs a signal for validating the IP telephone relay unit upon reception of a connection request from the network terminal*. Therefore, Pietrowicz in view of Wu makes obvious all limitations of the claim.

**Claim 17** is limited to *the IP telephone system as claimed in claim 15*, as covered by Pietrowicz in view of Wu. Pietrowicz mentions variously throughout the disclosure that ringing signals are generated. The specific example of an external audio device used in the disclosure of Pietrowicz is a standalone answering machine. These inherently function by detecting and counting ringing signals, which means that the adapter of Wu inherently supplies ringing signals to the external audio device (i.e. *a ringing signal output unit configured to output a ringing signal to the external telephone upon reception of a connection request from the network terminal*). Therefore, Pietrowicz in view of Wu makes obvious all limitations of the claim.

**Claim 19** is limited to *the IP telephone system whose components are analogous in nature to those recited in claim 12*, and is rejected for the same reasons.

**Claims 20 and 32** are essentially the same as claim 1 and are rejected for the same reasons.

**Claims 21, 23-25, 30, and 31** are essentially the same as claims 2, 4-6, 11, and 12, respectively, and are rejected for the same reasons.

2. **Claims 3, 13, 14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pietrowicz in view of Wu and further in view of Erikson.**

**Claim 3** is limited to *the IP telephone apparatus as claimed in claim 1*, as covered by Pietrowicz in view of Wu. While it has been shown that it would have been obvious to use an external telephony device at the audio port (156) disclosed by Pietrowicz, no specific handset was suggested. Therefore, Pietrowicz in view of Wu makes obvious all limitations of the claim with the exception *wherein the external telephone connection unit comprises a radio communication section for communicating with the external telephone by radio*.

Erikson teaches a voice-over-IP interface for standard household telephones. See Abstract. In the exemplary figure 1, the sound system interface, which corresponds to the audio port (156) of Pietrowicz, a base station transceiver (54) is connected in order to allow bidirectional communication between the dual-network interface and a cordless handset (66) by way of radio waves. Erikson further suggests that the wireless interface allows freedom of movement over typical corded telephone handsets. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the base station transceiver at the audio port as taught by Erikson for the purpose of extending the range that the dual-network interface can be used by a user.

**Claims 13 and 14** include reference to a cordless slave handset, which is made obvious in view of the rejection of claim 3.

**Claim 22** is essentially the same as claim 3, and is rejected for the same reasons.



3. **Claims 7, 9, 10, 26, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pietrowicz in view of Wu and further in view of Pulver (US Patent 6,741,835).**

**Claim 7** is limited to *the IP telephone apparatus as claimed in claim 1*, as covered by Pietrowicz in view of Wu. Up to this point, it has been shown that the dual-network interface as disclosed by Pietrowicz is incomplete in its description, but the procedure taught by Wu makes up for these deficiencies. However, the procedure of Wu does not suggest any machine-generated instructions that are delivered to a user of an external handset. Therefore, Pietrowicz in view of Wu makes obvious all limitations of the claim with the exception of *a message transmission unit that sends to the external telephone a guidance message*. Upon further analysis of the procedure taught by Wu, it is apparent that the guidance message recited in the claim would be placed between steps (402) and (403).

Pulver suggests delivering an audio message to a user of an external telephone indicating for them to enter a key combination that they might normally not enter when using the external device for its originally intended purpose. Clearly, this is beneficial for reminding a user that wishes to perform a certain function, but may have forgotten the exact procedure. It is also clear that by informing a user of their request if they have forgotten, timesavings will be made so that they don't have to consult a reference for the instructions. It follows that such a procedure is extensible to any decision point where a user is confronted with options that are beyond the scope of the normal routine. In the case of the procedure taught by Wu, the decision point at step (403) requires that a user enter a predetermined DTMF key to continue in a packet-based mode. It would have

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been obvious to one of ordinary skill in the art at the time of the invention to include a guidance message as taught by Pulver for the purpose of informing a user as to their required input in the event they have forgotten the necessary response, and to speed up processing of their request.

**Claim 9** is limited to *the IP telephone apparatus as claimed in claim 7*, as covered by Pietrowicz in view of Wu and further in view of Pulver. The disclosure of Pulver teaches that the notifying message can be an audio tone or a text message displayed on a screen of the wireless device therein. Because Pietrowicz doesn't include the wireless device, it would have been obvious to use the LCD display that is part of the user I/O devices section (124) that is a part of the desktop appliance (100) (i.e. *a message notifying unit configured to notify a message to a user; and the message transmission unit controls the message notifying unit to notify the guidance message to the user*). Therefore, Pietrowicz in view of Wu and further in view of Pulver makes obvious all limitations of the claim.

**Claim 10** is limited to *the IP telephone apparatus as claimed in claim 9*, as covered by Pietrowicz in view of Wu and further in view of Pulver. As shown in the rejection of claim 9, the LCD display disclosed by Pietrowicz is used for indicating the *guidance message* to the user of the external handset (i.e. *wherein the message notifying unit includes at least one of a display configured to display the message and a loudspeaker configured to output the message*). Therefore, Pietrowicz in view of Wu and further in view of Pulver makes obvious all limitations of the claim.

**Claims 26, 28, and 29** are essentially the same as claims 7, 9, and 10, respectively, and are rejected for the same reasons.

***Allowable Subject Matter***

4. **Claims 8, 18 and 27** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Claim 8** is limited to *the IP telephone apparatus as claimed in claim 7*, as covered by Pietrowicz in view of Wu and further in view of Pulver. The procedure of Pulver includes the option of allowing a subscriber to initiate communications over either the PSTN or a packet-based network. See Abstract. However, analysis of the procedure depicted in figure 4A shows that the procedure always requires a user selection. In contrast, the claimed invention allows a fixed mode, where no decision is necessary. Therefore, Pietrowicz in view of Wu and further in view of Pulver makes obvious all limitations of the claim with the exception of *a fixed mode*.

Schornack teaches yet another dual-network adapter. See Abstract. This adapter also includes the ability for a user of an external handset to select the network that outgoing calls will be made on. See figure 13. However, the decision can be defaulted as shown in steps (978) and (982). This supercedes the user's decision in steps (984) and (988), thus, a fixed mode is set. However, the examiner submits that even if the procedure between Wu and Pulver was further modified to include the defaulting functions as taught by Schornack, there is no motivation for the messaging transmission unit of claim 7 to indicate to the external user that a fixed mode of

operation is indeed in use, as no decision is being made by the user. Therefore, claim 8 is allowable over Pietrowicz in view of Wu in view of Pulver and further in view of Schornack.

**Claim 27** is essentially the same as claim 8, and is rejected for the same reasons.

**Claim 18** is limited to *the IP telephone system as claimed in claim 15*, as covered by Pietrowicz in view of Wu. The call receiving procedure described in figure 5 of Wu assumes that incoming calls are received on a single transmission medium and are differentiated in type by their ring cadence. This clearly does not allow for modes to be set such that the presence of only one type of call is made aware to the external telephone. Therefore, Pietrowicz in view of Wu makes obvious all limitations of the claim with the exception of *a mode setting unit configured to set a one calling mode for sending a ringing signal to the external telephone only when a connection request is received from one of a calling party on the telephone network and the network terminal*. Thus, claim 18 is allowable over Pietrowicz in view of Wu.

### ***Response to Arguments***

Applicant's arguments filed 01 April 2005 have been fully considered but they are not persuasive.

**With respect to claims 1, 15, 20 and 32**, the applicant alleges on pages 12 and 13 of the current response that Pietrowicz does not disclose, teach or suggest an external telephone connection unit connectable to an external telephone; the examiner

respectfully disagrees. It is noted that the audio stream produced by the analog telephony processor and switching & bridging system comprises only audio stream information, however, Pietrowicz further discloses that control is provided between the user audio devices, including the external audio device, and the application controller by control signals that are simply not illustrated. See paragraph 27. In this way, control of external telephones is possible. Furthermore, Pietrowicz discloses that an answering machine is just one type of device connectable to the audio port. See paragraph 25, lines 6-7. Prior art answering machines are known in the art to respond to ringing signals. In this way, an audio ringing signal applied to the external audio port comprises not just audio data but a control signal as well.

**With respect to claims 1 and 20**, the applicant alleges on pages 13 and 14 of the current response that Wu does not provide disclosure or motivation to suggest a dialing start command detection unit configured to detect and "IP telephone dialing start command," as recited; the examiner respectfully disagrees. The applicant relies on the fact that Wu discloses an analog telephone interface, which is consistent with the interface provided by Pietrowicz. The applicant then concludes that Wu cannot disclose, teach or suggest a digital telephone interface. While it may be true that Wu cannot disclose, teach or suggest a digital telephone interface, it is also irrelevant because it is based on an incorrect interpretation of the claim as recited. The claim recites that the dialing start command detection unit is not necessarily digital, but that it only need be configured to detect an IP telephone dialing start command; i.e. a key or sequence of keys pressed in order to start executing an IP telephone dialing.

**With respect to claims 1, 20 and 32**, the applicant alleges on pages 14 and 15 of the current response that Wu does not provide disclosure or motivation to suggest a handset validation unit configured to selectively validate between two handsets. As worded above, the handset validation unit recited appears to select between two handsets, while as actually recited, the handset validation unit need only selectively validate one of the handsets. In this way, the claim clearly reads on the off-hook detection scheme of Wu. Like the argument concerning the dialing start command, applicant's conclusion is rendered moot as the claim simply does not recite selecting between two handsets.

**With respect to claims 1, 15, 20 and 32**, the applicant alleges on page 15 of the current response that the combination of Pietrowicz in view of Wu is improper as it appears to be based on impermissible hindsight reasoning; the examiner respectfully disagrees. The applicant reasons that neither Pietrowicz nor Wu suggest the desirability of combining their teachings, however, it is well established that motivation can come from the implicit nature of prior art disclosures as well as the knowledge available to one of ordinary skill in the art. To that end, it is submitted that the mere fact that Pietrowicz fails to disclose how to select an outgoing network using an external device or even a handset integrated within the desktop appliance inherently requires a teaching from within the prior art, without which, the device of Pietrowicz would not be operable. This constitutes an implicit teaching from Pietrowicz that motivates combining the teachings of Pietrowicz with those of Wu.

**With respect to claims 2-7, 9-14, 16-17, 19, 21-26 and 28-31**, the applicant alleges on pages 15 and 16 of the current response that these claims are allowable over the cited prior art because of their dependence from claims 1, 15, 20 and 32; the examiner respectfully disagrees for at least the reasons provided above. As all of the applicant's arguments have been found to be either moot or unpersuasive, the rejections of claims 1-7, 9-26 and 28-32 are maintained.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F. Briney III whose telephone number is 571-272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WFB  
8/18/05

  
**SUHAN M.**  
**PRIMARY EXAMINER**